

R-2000-59

UNITED STATES PATENT AND TRADEMARK OFFICE MAY 12 2000
BEFORE THE DIRECTOR
OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re

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Decision on
Petition for Regrade
Under 37 C.F.R. § 10.7(c)

MEMORANDUM AND ORDER

(petitioner) petitions for regrading her answers to questions 7 and 32 of the morning session and questions 9, 11, 23, 27 and 31 of the afternoon session of the Registration Examination held on November 3, 1999. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

BACKGROUND

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in the Registration Examination. Petitioner scored 66. On January 14, 2000, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, all regrade requests have been considered in the first instance by the Director of the USPTO.

OPINION

Under 37 C.F.R. § 10.7(c), petitioner must establish any errors that occurred in the grading of the examination. The directions state: “No points will be awarded for incorrect answers or unanswered questions.” The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. Any reference to a practitioner is a reference to a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the *Official Gazette*. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is “All of the above,” the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer which refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement *true*. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms “USPTO,” “PTO,” or “Office” are used in this examination, they mean the U.S. Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers.

All of petitioner’s arguments have been considered. Each question in the examination is worth one point.

Petitioner has been awarded two points for afternoon questions 11 and 19. Accordingly, petitioner has been granted an additional two points on the examination, resulting in a regraded score of 68. However, no credit has been awarded for answers to questions 7 and 32 of the morning session and questions 9, 23, 27 and 31 of the afternoon session.

Morning question 7 reads as follows:

7. Which of the following statements, regarding amendments filed after final rejection in a timely manner, is correct?

- (A) Amendments touching upon the merits of the application presented after final rejection shall be entered upon payment of the proper fee and a showing of good and sufficient reasons why they are necessary and were not earlier presented.
- (B) An amendment filed after final rejection is entitled to entry if it amends only the claims that were finally rejected.
- (C) Amendments after final rejection may be made canceling claims or complying with any requirement of form expressly set forth in the final Office action.
- (D) An amendment after final rejections is entitled to entry if it cancels claims and adds new claims that clearly set forth a previously unclaimed embodiment of the invention.
- (E) Applicant cannot make any further amendments after final rejection, but may submit remarks and a notice of appeal.

Choice (C) is the most correct answer because amendments after final rejection may be made canceling claims or complying with any requirement of form expressly set forth in the final Office action 37 CFR § 1.116; MPEP § 714.13.

Petitioner contends that choice (A) is equally correct because 37 CFR § 1.116(b) states “If amendments touching the merits of the application or patent under reexamination are presented after final rejection, or after appeal has been taken, or when such amendment might not otherwise be proper, they may be admitted upon a showing of good and sufficient reasons why they are necessary and were not earlier presented.” Petitioner argues that this provision makes choice (A)

correct for reexamination applications and the question is sufficiently broad to encompass reexamination applications.

Petitioner's arguments are not persuasive. Choice (A) is not the correct answer because 37 CFR § 1.116(b) says amendments may be entered; choice (A) says amendments shall be entered. Choice (A) indicates that such amendments are entered as a matter of right ("shall be entered") but Rule 116(b) makes such entry discretionary ("may be entered"). Therefore, choice (A) is incorrect. Further, the examination instructions specifically state "Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions". This explicitly indicates that the question relates to regular applications rather than reexaminations. Thus, (A) is incorrect for the situation presented in the question. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 32 reads as follows:

32. On August 23, 1999, you file a patent application in the PTO. Along with the application, you file an unexecuted declaration that refers to the application and a preliminary amendment that describes the best mode of carrying out the claimed invention. Subsequently, you file a signed declaration in reply to a Notice to File Missing Parts. The best mode is described only in the preliminary amendment. In the first Office action, the examiner objects to the preliminary amendment as adding new matter to the specification and requires cancellation of the new matter. Considering the following responses and the additional facts separately, the best way to respond to and overcome the objection, and obtain a patent is to:

- (A) file a reply pointing out that the objection is improper because the declaration filed in reply to the Notice to File Missing Parts is a properly executed declaration that refers only to the amendment.
- (B) file a reply pointing out that the objection is improper because the declaration filed in reply to the Notice to File Missing Parts is a properly executed declaration that refers only to the application and amendment.
- (C) file a reply pointing out that the objection is improper because the declaration filed in reply to the Notice to File Missing Parts is a properly executed supplemental declaration that refers only to the amendment.
- (D) file an appeal to the Board of Patent Appeals and Interference requesting review of the examiner's objection to the amendment as adding new matter.
- (E) file a reply to the Office action canceling the new matter.

Choice (B) is the most correct answer because when an amendment accompanies a non-provisional patent application filed without a signed declaration, the amendment is considered part of the original disclosure, provided that the subsequently filed declaration refers to both the patent application and the amendment. MPEP §§ 608.04(b) and 714.09. Here, the application was filed with an unexecuted declaration, i.e., an unsigned declaration. Thus, the best way to overcome the rejection is for the executed declaration, filed in reply to the Notice to File Missing Parts, to have referenced both the application and amendment, and to alert the examiner to this fact in reply to the Office action.

Answer (A) is incorrect because the declaration must refer to both the application and amendment. MPEP §§ 608.04(b) and 714.09. Answer (C) is incorrect because the declaration filed in reply to the Notice was not a supplemental declaration because the prior-filed declaration was not signed and because, even if the original declaration had been signed, the original disclosure of an application cannot be altered by filing a supplemental declaration that refers to paper different from those referred to in the original declaration unless a petition under 37 CFR 1.182 is granted, as described in MPEP § 608.04(b). In addition Answer (C) is incorrect because

the declaration was required to reference the application as well as the preliminary amendment.

Answer (D) is incorrect because an examiner's objection to an amendment as adding new matter to the specification is a matter petitionable to the Commissioner, pursuant to 37 CFR § 1.181(a)(1). See also MPEP § 608.04(c). Answer (E) is incorrect because, while canceling the new matter will overcome the examiner's objection, it is not the best way to overcome the rejection because, after cancellation, the application will fail to set forth the best mode contemplated by the inventor of carrying the claimed invention. 35 U.S.C. § 112.

Petitioner contends that choice (E) is the correct answer because the examiner required rather than suggested the cancellation and the requirement allows for no other alternative.

Petitioner's arguments are not persuasive. Choice (E) is not the correct answer because the examiner has no authority to require that an applicant refrain from availing himself of the patent rules and regulations. Choice (B) is clearly within the patent rules and regulations because when an amendment accompanies a non-provisional patent application filed without a signed declaration, the amendment is considered part of the original disclosure, provided that the subsequently filed declaration refers to both the patent application and the amendment. MPEP §§ 608.04(b) and 714.09. Thus, (B) is appropriate for the situation presented in the question and choice (E) is incorrect. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 9 reads as follows:

9. A personal interview with an examiner to discuss the merits of the claims may not be properly conducted by:

- (A) the inventor, even though the attorney of record is present at the interview.
- (B) a registered practitioner who does not have power of attorney in the application, but who is known to the examiner to be the local representative of the attorney of record in the case.
- (C) an unregistered attorney who is the applicant in the application.
- (D) an unregistered attorney who has been given the associate power of attorney in the particular application.
- (E) a registered practitioner who is not an attorney of record in the application, but who brings a copy of the application file to the interview.

Choice (D) is the most correct answer because a personal interview with an examiner to discuss the merits of the claims may not be properly conducted by an unregistered attorney who has been given the associate power of attorney in the particular application. MPEP § 713.05. A power of attorney to an unregistered attorney is invalid. See MPEP § 402.

Petitioner contends that choice (E) is correct because MPEP § 713.05 gives the examiner discretion to conduct or not conduct an interview with a registered practitioner who is not an attorney of record in the application, but who brings a copy of the application file to the interview.

Petitioner's arguments are not persuasive. The question asks under which circumstance may an interview not be properly conducted. Choice (E) is not the correct answer because a registered practitioner may conduct a personal interview from his own file, under certain circumstances. Choice (D) is the correct answer because an unregistered attorney may not conduct an interview unless he is also the applicant in the application, or if the unregistered attorney is one of several inventors has been given a power of attorney (not an associate power of attorney) by the remaining inventors. Thus, (D) is the only situation where an interview would always be inappropriate and choice (E) is incorrect. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 23 reads as follows:

23. To avoid a proper rejection of a claim for being indefinite, which of the following expressions in the claims must be supported by a specification disclosing a standard for ascertaining what the inventor means to cover?

- (A) "relatively shallow."
- (B) "of the order of."
- (C) "similar" in the following claim preamble: "A nozzle for high-pressure cleaning units or similar apparatus."
- (D) "essentially" in the following phrase following the claim preamble: "a silicon dioxide source that is essentially free of alkali metal."
- (E) All of the above.

Choice (E) is the most correct answer because each of (A), (B), (C) and (D) must be supported. MPEP § 2173.05(b), "Reference To An Object That Is Variable May Render A Claim Indefinite," items B, C, and F. Each expression has been found to require support in the specification disclosing a standard for ascertaining what the inventor meant

Petitioner contends that each of choices (A), (B) and (C) are indefinite according to MPEP § 2173.05(b) and therefore cannot avoid a proper rejection for being indefinite.

Petitioner's arguments are not persuasive. Choice (D) is not the correct answer because each of choices (A), (B) and (C) may be definite if the specification discloses a standard or definition for the terms therein. MPEP § 2173.05(b) states "The fact that claim language, including terms of degree, may not be precise, **does not automatically render the claim indefinite** under 35 U.S.C. 112, second paragraph. *Seattle Box Co., v. Industrial Crating & Packing, Inc.*, 731 F.2d 818, 221 USPQ 568 (Fed. Cir. 1984). Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed, in light of the specification." (Emphasis added). Petitioner cites MPEP § 2173.05(b)(F) which states "The phrases "relatively shallow," "of the order of," "the order of about 5mm," and "substantial

portion” were held to be indefinite **because the specification lacked some standard for measuring the degree intended** and, therefore, properly rejected as indefinite under 35 USC § 112, second paragraph. *Ex parte Oetiker*, 23 USPQ2d 1641 (Bd. Pat. App. & Inter. 1992).” (emphasis added) to support petitioner’s argument that all three phrases are indefinite *per se*. This is not what MPEP § 2173.05(b)(F) says. That citation specifically limits the holding of indefiniteness to where the specification lacked a measurement standard as indicated by the emphasized portion above. That is, each of (A), (B) and (C) had the same requirement as (D) for support. Thus, each of choices (A), (B), (C) and (D) are appropriate for the situation presented in the question and choice (D) alone is incorrect. No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Afternoon question 27 reads as follows:

27. On April 21, 1998, a patent was issued to Belinda on a novel switching circuit. Shortly after receiving the patent grant, Belinda assigned 50% of her right, title and interest in her patent to Ace and 25% of the right, title and interest to Duce. After the assignments were recorded in the PTO, Belinda discovered that her claim coverage is too narrow because her patent attorney did not appreciate the full scope of her invention. Today, November 3, 1999, Belinda consults you about filing a reissue application. The reissue oath must be signed and sworn to by:

- (A) Belinda, Ace and Duce.
- (B) Belinda only.
- (C) Belinda and either Ace or Duce.
- (D) Ace and Duce only.
- (E) the attorney or agent of record.

Choice (B) is the most correct answer because the reissue oath must be signed and sworn to by the inventor only. 37 CFR § 1.172.

Petitioner contends that choice (C) is correct because 37 CFR § 1.172 requires written consent of all assignees and a consent is an affirmation.

Petitioner's arguments are not persuasive. Written consent is not an oath and an oath is not a consent. 37 CFR § 1.172 requirements include two distinctly different instruments, an oath and a written consent. Whether a consent may be characterized as an affirmation does not negate the distinction between an oath and a consent. Choice (C) is not the correct answer because Ace and Duce are not inventors. Thus, Ace and Duce are incorrect oath signatories for the situation presented in the question and choice (C) is incorrect. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 31 reads as follows:

31. An international application under the Patent Cooperation Treaty (PCT), which designated the United States, was filed on November 1, 1996. The application claimed priority of a prior French national application filed on December 6, 1995. A copy of the international application was communicated to the United States as a designated office on June 20, 1997. A demand for international preliminary examination, in which the United States was elected, was filed on June 5, 1997. Accordingly, the thirty month period of PCT Article 39(1)(a) expired at midnight on June 6, 1998. The applicant submitted the basic national fee to enter the United States national stage on June 2, 1998. On August 3, 1998, the applicant timely submitted a translation of the international application and a declaration of the inventors in compliance with PCT regulations in reply to a Notice of Missing Requirements. Also, on August 10, 1998, the applicant timely submitted a translation of amendments under Article 19 of the PCT in reply to the Notice of Missing Requirements. On August 29, 1998, a Notice of Acceptance was mailed to the applicant. The national stage application issued as a U.S. patent on October 13, 1999. What is the effective date of the U.S. patent as a reference under 35 U.S.C. § 102(e)?

- (A) November 1, 1996.
- (B) June 2, 1998.
- (C) August 3, 1998.
- (D) August 10, 1998.
- (E) October 13, 1999.

Choice (C) is the most correct answer because August 3, 1998 was the date on which the requirements of 35 U.S.C. § 371(c)(1), (2), and (4) were completed. PCT Articles 11 and 20; PCT Rule 47.1(c); and 35 U.S.C. § 102(e) which states that a person shall be entitled to a patent unless "the invention was described in a patent granted on...an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by applicant for patent."

Petitioner contends that choice (D) is correct because a translation of amendments required by the Office was not submitted until August 10, 1998 and no filing date would have been granted earlier than when the required translation was submitted. Petitioner further argues that the effective date of a reference under 35 USC § 102(e) is the effective US filing date and not the foreign priority date and that the effective US filing date was the date the translation requirement was met, August 10, 1998.

Petitioner's arguments are not persuasive. Choice (D) is not the correct answer because 35 USC § 102(e) explicitly says "A person shall be entitled to a patent unless-

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent."

Applicant provided a translation of the original application August 3, 1998, as required by 35 USC § 371 (c)(2)(a). Therefore all requirements of paragraphs (1), (2), and (4) of section 371(c) were met by August 3, 1998 and that same date would become the effective date of the application as prior art under 35 USC § 102(e). The Office requirement for a translation of

amendments arose from 35 USC § 371(c)(3), which is not among the statutory sections required to have been met for setting an effective filing date under 35 USC § 102(e). Petitioner's arguments that the foreign priority date is not the effective date as a reference and that a filing date would not be granted until the amendment translation was provided are not relevant to the instant question. MPEP § 1896 shows that both the filing date and effective date as a 35 USC § 102(e) reference differs between applications filed under 35 USC § 111(a) and under 35 USC § 371. Petitioner's arguments are directed toward applications filed under 35 UCS 111 (a) but are not relevant to applications filed under 35 USC § 371. Exam question 31 is implicitly directed to an application filed under 35 USC § 371. (The applicant submitted the basic national fee to enter the United States national stage on June 2, 1998.) Thus, (D) is incorrect for the situation presented in the question. No error in grading has been shown. petitioner's request for credit on this question is denied.

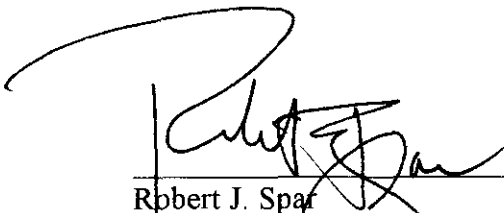
No error in grading has been shown as to answers to answers to questions 7 and 32 of the morning session and questions 9, 23, 27 and 31 of the afternoon session of the Registration Examination held on November 3, 1999. Petitioner's request for credit on these questions is denied.

ORDER

For the reasons given above, two points have been added to petitioner's score on the Examination. Therefore, petitioner's score is adjusted to 68. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.



Robert J. Spar
Director, Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy